Please add new claim 8 as follows:

--8. An adhesive composition according to claim 1, wherein the oxetan compound is selected from the group consisting of xylylene dioxetan and bis ((1 - ethyl (3 - oxetanyl)) methyl) ether.--

REMARKS

Claims 1-8 are pending. By the Office Action, claims 1-7 are rejected. By this Amendment, claims 1, 3 and 5 are amended and claim 8 is added. No new matter is added.

The attached Appendix includes a marked-up copy of each rewritten claim (37 C.F.R. §1.121(c)(1)(ii)). Support for the amended claims and new claims can be found in the original claims and in the specification.

Claims 3 and 5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for reciting the phrase "anisotropic conductive adhesive" in the preamble. By this Amendment, claims 3 and 5 are amended to remove the objectionable phrase. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,674,922 to Igarashi et al. (Igarashi). Applicant respectfully traverses the rejection.

Claims 1 and 2 are directed to an adhesive composition comprising an oxetan compound having two oxetane functional groups. Support for this claim feature can be found on page 7, line 2 to page 8, line 3.

In contrast to the claimed invention, Igarashi discloses an active energy beam-curable composition comprising at least one compound having one oxetane ring and one hydroxyl group in the molecule. See the Abstract. At col. 2, lines 37-60, it is indicated that the disclosed compounds have one oxetane ring. Thus, it is clear that Igarashi does not teach every feature of claims 1 and 2. Specifically, Igarashi does not teach an adhesive composition comprising an oxetan compound having two oxetane functional groups.

For at least these reasons, Applicant submits that claims 1 and 2 are not anticipated by Igarashi. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-3 and 5 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,394,403 to Smith. Applicant respectfully traverses the rejection.

Claims 1-3 and 5 are directed to an adhesive composition comprising an oxetan compound having two oxetane functional groups. In contrast to the claimed invention, Smith discloses a photopolymerizable composition that includes cationically polymerizable organic materials. In col. 6, lines 21-37, it is indicated that oxetanes used include those represented by the formula on line 30, which has a single oxetane ring. Thus, it is clear that Smith does not teach every feature of claims 1-3 and 5. Specifically, Smith does not teach an adhesive composition comprising an oxetan compound having two oxetane functional groups.

For at least these reasons, Applicant submits that claims 1-3 and 5 are not anticipated by Smith. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Smith in view of Igarashi. As discussed above, neither Smith nor Igarashi teach, nor do they suggest, the adhesive composition comprising an oxetan compound having two oxetane functional groups as claimed in claim 2. Further, neither Smith nor Igarashi, alone or in any combination, provide motivation for one of ordinary skill in the art to modify their disclosed compounds, having one oxetane ring, to achieve the claimed invention.

Accordingly, Applicant submits that since neither Smith nor Igarashi, alone or in combination, teach or suggest every feature of claim 2, and provide no motivation to modify their respective disclosures to achieve the claimed invention, the Office Action has not established a *prima facie* case of obviousness.

For at least these reasons, it would not have been obvious to one of ordinary skill in the art, based on the disclosure of Smith, alone or in view of Igarashi, to practice the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 4 and 6-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Smith. Applicant respectfully traverses the rejection.

Claims 4 and 6-7 are all directed to an adhesive composition comprising an oxetan compound having two oxetane functional groups. As discussed above, Smith does not teach or suggest such an adhesive composition, nor does Smith provide motivation to one of ordinary skill in the art to modify the disclosure to practice the claimed invention. Accordingly, the Office Action has not established a *prima facie* case of obviousness.

For at least these reasons, it would not have been obvious to one of ordinary skill in the art, based solely on the disclosure of Smith, to practice the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-8 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

JAO:PAC/jca

Joel S. Armstrong
Registration No. 36,430

Attachment:
Appendix

Date: May 10, 2002

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461

APPENDIX

Changes to Claims:

The following is a marked-up version of the amended claims:

1. (Amended) An adhesive composition, comprising:

an insulating resin;

a photopolymerization initiator; and

an oxetan compound having two oxetane functional groups.

3. (Twice Amended) The ~~anisotropic conductive~~ adhesive composition according to claim 1, further comprising electrically conductive particles.

5. (Amended) The ~~anisotropic conductive~~ adhesive composition according to claim 2, further comprising electrically conductive particles.